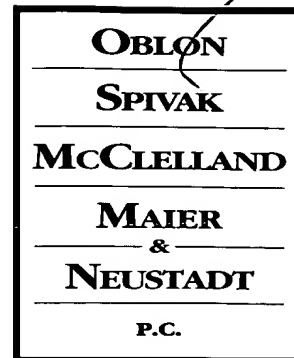




Docket No.: 216597US2PCT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW
— GREGORY J. MAIER —
(703) 413-3000
GMAIER@OBLON.COM

RAYMOND F. CARDILLO, JR.
(703) 413-3000
RCARDILLO@OBLON.COM

RE: Application Serial No.: 09/926,686
Applicants: Adriano HUBER, et al.
Filing Date: December 3, 2001
For: METHOD FOR SELLING AND USING MEDIA
OBJECTS AND A DEVICE SUITABLE THEREFOR
Group Art Unit: 3621
Examiner: Bayat, B.B.

SIR:

Attached hereto for filing are the following papers:

APPEAL BRIEF WITH APPENDICES

Our credit card payment form in the amount of **\$500.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gregory J. Maier
Registration No. 25,599
Attorney of Record

Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)

Raymond F. Cardillo, Jr.
Registration No. 40,440

DOCKET NO: 216597US2PCT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
ADRIANO HUBER, ET AL. : EXAMINER: BAYAT, B. B.
SERIAL NO: 09/926,686 :
FILED: DECEMBER 3, 2001 : GROUP ART UNIT: 3621
FOR: METHOD FOR SELLING AND :
USING MEDIA OBJECTS AND A
DEVICE SUITABLE THEREFOR

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is an appeal of the final Action mailed April 7, 2006, that presented a final rejection of Claims 1-22. A Notice of Appeal was timely filed on August 31, 2006.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is the Assignee SWISCOM MOBILE AG.

II. RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative, and the assignees are aware of no appeals which will directly affect or be directed affected by or have a bearing on the Board's decision in this appeal.

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III. STATUS OF THE CLAIMS

Claims 1-22 are pending in this application. Claims 1-22 have been finally rejected and form the basis for this appeal. The attached claim appendix includes a clean copy of appealed Claims 1-22.

IV. STATUS OF THE AMENDMENTS

No amendments have been filed after the final Action mailed April 7, 2006. A Request for Reconsideration was filed on July 7, 2006, which resulted in an Advisory Action being mailed on August 16, 2006. The Advisory Action indicated that this Request for Reconsideration was not considered persuasive as to overcoming the prior art rejection and did not place the Application in condition for allowance.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The subject matter of method Claim 1 relates to a method for ordering and transmitting digital media objects (see, e.g. element 6 of FIG. 2). The method includes transmitting an object order for digital media objects that includes at least one object identification (reference numeral 61 of FIG. 2, described at page 7, lines 4-10, for example) by a mobile communications terminal (1) over a mobile radio network (2) to a center (3). See FIG. 1 and note page 5, line 12 – page 6, line 3, for example. It further includes transmitting data on a time at which an ordered media object is available by the center (3) to the communications terminal (1), wherein the time is determined by the center (3) with regards to optimal usage of resources used for a transmission of ordered media objects (6) and is stored in the communications terminal (1), which then automatically contacts the center (3) at the time to cause the media object assigned to the object identification by the center to be transmitted via radio to the communications terminal (1). See page 10, lines 6-15, for

example. The media object received by the communication terminal (1) is stored in a memory (12, see page 6, lines 24-29) and played back by a media playback module (13, see page 8, line 34 – page 9, line 14 of the specification, for example).

The subject matter of apparatus Claim 13 is drawn to the mobile communications terminal (1, see FIGS. 1 and 2, for example) that will receive data disseminated over a radio network and communicate over a mobile radio network (2, see FIG. 1, and page 6, line 32 – page 7, line 23, for example). This mobile communications terminal (1) includes a memory means (13) for storing digital media objects received over the radio network, where this memory means (13) is connected to at least one processor (7). See page 6, lines 24-29, for example. This mobile communications terminal (1) also includes a programmed order module (121) that will transmit an object order (including object identification) for digital media objects over the mobile radio network to a center (3). See page 9, lines 26-34, for example. The mobile communications terminal (1) further includes a media playback module (13) that will play back a media content of one of the digital media objects via a suitable medium as described at page 8, line 34 – page 9, line 14, for example. The order module (121) will further receive and store a time, determined by the center (3) with regards to optimal usage of resources used for a transmission of ordered media objects and transmitted to the communications terminal (1) that will then contact the center (3) at the time so that a media object assigned to the object identification that is transmitted by the center (3) to the communication terminal (1) can be stored in the memory means (13).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-22 stand rejected under 35 U.S.C. §103(a) as unpatentable over Downs et al. (U.S. Patent No. 6,226,618, hereinafter “Downs”) in view of Zhao et al. (Sigmetrics

publication of 5/99 entitled “Bandwidth-Efficient Continuous Media Streaming Through Optimal Multiplexing,” hereinafter “Zhao”).

VII. ARGUMENT

A. Independent Claims 1 and 13

Page 3 of the outstanding final Action¹ (in the paragraph beginning after the statement of the rejection asserts relative to Claim 1 that Downs “discloses a method for ordering and transmitting of digital objects that comprises at least one object identification (figure 1b, 1d, 2 and associated text), transmitting data on a time at which an ordered media object is available by the center to any communications terminal, wherein the time is determined by the center and is stored in the communications terminal (column 6, line 35-column 8, line 54; column 40, lines 53-67; column 46, lines 10-61), automatically contacting, by the communications terminal the center at the stored time (column 58, lines 1-column 59, line 48), transmitting a media object assigned to the object identification by the center via radio network to the communications terminal where it is stored in a memory and playing back, by a playback module of the communications terminal, a media contained in the stored media object (figures 1A-D; columns 6-8; figures 12, 13 and associated text).” No separate statement is made as to Claim 13. Instead, Page 6 of the final Action simply states that “Claims 13-22 are directed to a device or terminal of the above claimed method and are therefore rejected on the same grounds (see above).” Thus, the arguments below that are specific as to why the

¹ This statement of reliance on the noted portions of Downs is followed by a general assertion (in the paragraph bridging pages 6 and 7) that other parts of the references may “apply to the claimed invention.” Even if this were true, the consideration of the rejections is limited to the parts of Downs and Zhao that have been relied on as Applicants have been given no opportunity to comment on such other teachings. See *In re Arkley*, 455 F.2d 586, 589, 172 USPQ 524, 527 (CCPA 1972).

rejection of Claim 1 is improper and should be reversed also establish that the rejection of Claim 13 is improper and should also be reversed.

1. The rejection rationale offered fails to consider all words in the claims and to present a proper analysis relative as thereto.

The above noted explanation of the rejection at page 3 of the outstanding final Action is first deficient because it fails to consider all the words presented by the rejected claims. It is well established that each word of every claim must be given weight. *See In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Instead of this required consideration of all the words of the first step of Claim 1 and similar language in Claim 13, for example, page 3 of the final Action rewrites this step to only recite “ordering and transmitting of digital objects that comprises at least one object identification.” Thus, the actual words of these claims requiring the transmission order to be “by a mobile communications terminal over a mobile radio network to a center” have been erroneously left unconsidered, a clear violation of the above-noted *Wilson* requirement.

The Action mailed September 30, 2004, attempted to circumvent the lack of any clear teachings of the Claim 1 requirements for transmitting an order “by a mobile communications terminal over a mobile radio network to a center” (and similar requirement of Claim 13) by simply assuming, without any supporting evidence, that although Downs does not teach the claimed transfer of digital media via a mobile communications terminal, because of a secondary reference that is no longer applied and because of the completely subjective conclusory opinion offered at page 4 of this Action that it was considered obvious “to utilize the method of transfer and purchase of digital data via a mobile device to carryout and augment the electric content delivery system described in Downs, as more users in the digital

transfer technology are utilizing mobile phones and devices for other modalities foreseeable in the art.”

Not only does the failure to consider the Claim 1 words “by a mobile communications terminal over a mobile radio network to a center” (and similar content of Claim 13) violate the rule set forth in the *Wilson* decision, it violates the requirement of *Gechter v. Davidson* 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) as to proper analysis of all claim terms including adequate findings of fact as to how the references relied on teach such terms.

Contrary to *Gechter*, the Claim 1 and Claim 13 requirements for “a mobile communications terminal,” a mobile radio network” and “a center” are not in anyway analyzed and no findings are made as to what disclosed elements in Downs and/or Zhao reasonably correlate thereto. Similarly, there is no attempt in the outstanding final Action to properly consider the requirements of the Claim 1 step of “transmitting a media object assigned to the object identification by the center via a radio network to the communications terminal, where the media object is stored in a memory” (and corresponding Claim 13 structure) in terms of identifying anything in the references that reasonably teaches “the center” or the required transmission of “object identification” by this center “via a radio network to the communications terminal.”

To the extent that the PTO would attempt to resurrect this departed rationale, it is noted to violate both recent and past precedent of the PTO reviewing court.

As to past precedent, see *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”). As to more recent precedent requiring evidence, not unfounded assumptions

and conclusions, *see In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697-98 (Fed. Cir. 2001) noted that:

Finally, the deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is "basic knowledge" or "common sense" to one of ordinary skill in the art. As described above, the Board contended that even if the cited UNIX and FILER2 references did not disclose a trusted path, "it is basic knowledge that communication in trusted environments is performed over trusted paths" and, moreover, verifying the trusted command in UNIX over a trusted path is "nothing more than good common sense." Ex parte Zurko, slip op. at 8. We cannot accept these findings by the Board. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience — or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise. *Baltimore & Ohio R.R. Co. v. Aderdeen & Rockfish R.R. Co.*, 393 U.S. 87, 91-92 (1968) (rejecting a determination of the Interstate Commerce Commission with no support in the record, noting that if the Court were to conclude otherwise "[t]he requirement for administrative decisions based on substantial evidence and reasoned findings — which alone make effective judicial review possible — would become lost in the haze of so-called expertise"). Accordingly, we cannot accept the Board's unsupported assessment of the prior art. [Emphasis added, footnote omitted.]

An even more recent decision by the Federal Circuit Court of Appeals in *In re Lee*, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) has emphasized the need for both examiners and the board to provide evidence, not mere unsupported opinion, as follows:

In finding relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint [that of the person of ordinary skill in the art to which the subject matter pertains]. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administration procedure or effective judicial review. (Emphasis added.)

With further regard to relied on general teachings associated with figure 1b, 1d, 2, and associated text, the particular parts therein that are being relied on to teach the above-noted claim requirements as to the first transmitting step of Claim 1 and corresponding structure of Claim 13 are never specified. Such general incorporation of large scale disclosures encompassing many elements and many different options as to operation is not seen to comply with the 37 CFR § 1.04(c)(2) requirement that all claim rejections “for want of novelty or for obviousness” are to designate “the particular part relied on” whenever “a reference is complex or shows or describes inventions other than that claimed by the applicant,” as is the case with Downs. Further note *Lee*, at 277 F.3d 1338, 1342, and at 61 USPQ2d 1430, 1432-33, and the requirement there that the PTO must “... present a full and reasoned explanation of its decision.”

The final Action contains similar violations of precedent as to the position therein that some hidden disclosure in column 6, line 35-column 8, line 54; column 40, lines 53-67; column 46, lines 10-61 can be said to teach or suggest transmitting data on a time at which an ordered media object is available by the center to any communications terminal, wherein the time is determined by the center and is stored in the communication terminal.” Once again the final Action fails to point to the elements in the hodgepodge referenced that are believed to perform as the claimed “center,” the claimed “communication terminal,” or storage of time in this “communication terminal.”

In this regard, column 6, line 35-column 8, line 54, consists mostly of a system overview of the Downs system that lacks any details relevant to the second step of Claim 1 or corresponding structure in Claim 13. Thus, while the Clearinghouse(s) entity is taught to be used to insure valid (authorized) licensing (column 7, lines 11-16, insuring that a license has not expired using such a Clearinghouse(s) entity has nothing to with the second step of Claim 1 or corresponding structure of Claim 13 that requires the availability time to be determined

by the same “center” doing the transmitting to the communications terminals and that this time is then stored at the communication terminal.

While column 40, lines 53-67 and lines 10-61, all relate to logging (or storing) dates, these are dates that are logged at the clearing houses 105 when report requests are made and when results are reported, all as clearly stated at column 45, lines 65-66 considered with column 46, line 5, and column 46, lines 63-67. The final Action fails to present any explanation as to what the logging at clearing house 105 into Audit Logs 150 shown in FIG 1C of such report items has to do with storing a time at something that can be said to be a communications terminal as recited by Claims 1 and 13.

Furthermore, Claims 1 and 13 require the communications terminal to then automatically contact the center at the time, which means that the clearing houses 105 that have logged the report dates must automatically contact something that can be reasonably said to operate as the claimed center if the PTO rationale as to logging dates is to be believed to correlate to the above noted storage of the time. However, the final Action jumps from considering the logged report dates by clearing houses 105 to the completely unrelated topic of the automatic multimedia acquisition tool that is described at relied on column 58, lines 1- column 59, line 48 of Downs.

However, this portion of Downs teaches an automatic metadata acquisition process allowing the retrieval of as much data as possible from a content provider database 160 of the content providers 101 without operator assistance. See Downs at column 58, lines 24-29, for example. This Downs automatic metadata acquisition tool is clearly taught to retrieve metadata describing the content based on template data fields at column 58, lines 30-55, as follows:

The Content Provider(s) 101 can tailor the default metadata template to identify the types of data this Content Provider(s) 101 wants to provide to End-User(s) (e.g., composer, producer, sidemen, track length) and the types of promotional data the Content Provider(s) 101 provides to the Electronic

Digital Content Store(s) 103 (e.g., for a music example, sample clips by this artist, a history of this artist, the list of albums on which this recording appears, genres associated with this artist). The default metadata template includes data fields which are required by the End-User Device(s) 109, data fields which can be optionally provided to the End-User Device(s) 109 and a sample set of data fields, targeted to the Electronic Digital Content Store(s) 103, that promote the artist, album, and/or single.

To extract the template data fields from the Database 160 of the Content Provider(s) 101 the Automatic Metadata Acquisition Tool uses a table that maps the type of data (e.g., composer, producer, a biography of the artist) to the location within the database where the data can be found. Each of the Content Provider(s) 101 help specify that mapping table for their environment.

The Automatic Metadata Acquisition Tool uses a metadata template of the Content Provider(s) 101 and mapping table to acquire whatever data is available from the Databases 160 of the Content Provider(s) 101. The status of each product is updated with the result of the Automatic Metadata Acquisition Process 803. A product which is missing any required data is queued for Manual Metadata Entry Process 804, otherwise it is available for packing into a Metadata SC(s) 620

Further note Downs at column 9, lines 21-32, for example, as to the nature of “metadata” and database 160 as follows:

The term metadata is used throughout this document to mean data related to the Content 113 and in this embodiment does not include the Content 113 itself. As an example, metadata for a song may be a song title or song credits but not the sound recording of the song. The Content 113 would contain the sound recording. A Metadata Assimilation and Entry Tool 161 is used to extract metadata from the Content Provider(s)' Database 160 (for a music example the Content 113 information such as CD title, artist name, song title, CD artwork, and more) and to package it for electronic distribution. The Metadata Assimilation and Entry Tool 161 is also used to enter the Usage Conditions for the Content 113.

Whatever else can be said as possibly included as part of the data in database 160, it cannot be reasonably said that Downs teaches that data from the logs 150 is stored in the database 160 of FIG 1A or somehow transferred from logs 150 to the database 160.

Applicants further disagree with the time assertions made in the final Action because Downs merely teaches that a work flow manager 154, located at the content provider 101, is responsible for scheduling content processing activities, not any automated contact based on

a stored time. See Downs from column 49, line 12 to column 50, line 32 and in Figure 1A, for example. A work flow manager queuing new jobs at the content provider 101 cannot be reasonably said to read as a communications terminal automatically contacting the center at a determined time, as claimed in both Claims 1 and 13.

Furthermore, these claims require that the communications terminal plays back the media content, which is also not reasonably read on the work flow manager of Downs. Thus, it is not reasonable for the outstanding final Action to equate the work flow manager of Downs to Applicants' communications terminal or the steps performed by this work flow manager of Downs to the subject matter of Applicants' claims.

Moreover, and as acknowledged at page 3, lines 12-13 of the final Action, Downs *does not disclose* transmission of media objects at a time for optimal usage of resources. The Downs content provider 101 starts delivering metadata information to an end-user as soon as the end-user purchases a product. See Downs at column 58, lines 5-9, for example.

Accordingly, Downs not only fails to teach or suggest that a time of transmitting data is determined by the center with regards to optimal usage of resources used for a transmission of ordered media objects, it also fails to teach or suggest that the communications terminal automatically contacts the center at the recited time.

Thus, a reversal of the outstanding rejection of Claims 1 and 13 for all the above-noted reasons is clearly in order

2. The rejection rationale improperly combines divergent and unrelated reference teachings of Downs without establishing any showing of motivation as to such combinations.

Even where only a single reference is being considered, modifications of that reference cannot be based upon simply identifying unrelated components that are not taught

by the reference to be combined. *See In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) as follows:

While the test for establishing an implicit teaching, motivation, or suggestion is what the combination of these two statements of [the reference] would have suggested to those of ordinary skill in the art, the two statements cannot be viewed in the abstract. Rather, they must be considered in the context of the teaching of the entire reference. Further, a rejection cannot be predicated on the mere identification in [the reference] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

The rule is further well established that it is clear error to pick and choose from a reference disclosure only bits and pieces that appear to support a given position while excluding the other parts of the teaching which are necessary for a full appreciation of what is actually fairly suggested to one of ordinary skill in the art. *See In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965).

As the final Action presents absolutely no explanation as to the reasons why the worker of ordinary skill would pick the various unrelated Downs disclosures relied upon for combination, the lack of a valid prima facie case is clear on this grounds alone and a reversal of the rejection of Claims 1 and 13 for this reason as well is clearly in order.

3. The rejection rationale offered fails to properly interpret the teachings of Zhao that clearly point to a direction divergent from the path of the claimed invention and the path of Downs

Zhao describes bandwidth-efficient continuous media streaming (see Zhao in the Title and in the Abstract, for example), where continuous media are streamed from a media server to a set of distributed receivers, as taught by Zhao at page 13, column 2, lines 32-35 and in Figures 1 and 2, for example. The media server determines a streaming schedule for immediate delivery of a requested media object by the server to a receiver through a

continuous streaming process according to the streaming schedule. See Zhao at page 15, column 2, paragraph 2.3.

However, streaming data with a streaming schedule determined by a server² *is not* transmitting data on a time determined by the center with regards to optimal usage of resources used for a transmission of ordered media objects, as recited in Claim 1. Also, as Zhao's time of initiating streaming is always $t = 0$, the streaming is intended to start immediately after the request. Zhao's schedule thereby adapts the bit rate as a function of time, as shown in Zhao's Figures 5a and 5b. Accordingly, Zhao fails to reasonably teach or suggest transmitting data on a time determined by the center with regards to optimal usage of resources used for a transmission of ordered media objects, much less automatically contacting the center by the communications terminal at the determined time.

Furthermore, Zhao teaches away from the features of Claims 1 and 13 by explicitly stating "[w]e use the term *streaming* to distinguish itself form the alternate approach of downloading and playing back."³ "A reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F. 3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

Page 3, lines 1-3, of the final Action asserts the language of Applicants' claims does not make a distinction between streaming media objects and the features in Applicants' Claim 1. However, Claim 1 recites "transmitting a media object ... to the communications terminal, where the media object is stored in a memory," and further recites "playing back ... a media content included in the stored media object." In other words, first a media object is stored, and subsequently, the media content of the media object is played back. In contrast, the Zhao stated definition of the word streaming is clear and contrary to any approach involving downloading and play-back as noted above.

² See Zhao at page 15, column 2, lines 10-15 and in Figures 5a-b.

³ See Zhao at page 14, column 2, lines 12-17.

As it is clear from the features of Claims 1 and 13 that the media object is first stored in the memory, and then the media content of the media object is played back, it is clear that Claims 1 and 13 are not directed to streaming media content. Also, it is clear that Zhao teaches away from such features in the discussion of paragraph 2 of the right-hand column on page 14. Also, Downs is concerned with data pre-packaged by Content Providers 101 into SC(s) as described at column 9, lines 49-51. These SC(s) are to be “downloaded” by the end users (see column 11, lines 40-42, for example) that cannot be equated to data being “streamed” as in Zhao.

In addition, page 2, lines 15-18, of the final Action assert that “[t]he main feature of the Zhao reference is mechanisms for scheduling a time of transfer of media objects in order [to] optimize efficient bandwidth usage (see pp. 13-14). If in fact media objects were sent immediately, Zhao would not accomplish usage resource optimization.” Applicants respectfully disagree. As explained in the Abstract of Zhao, Zhao’s system is directed to media distribution by streaming, and the goal of Zhao is the maximizing of bandwidth efficiency, and not transmitting data on a time at which an ordered media object is available. Nowhere does Zhao reasonably teach or suggest the Claim 1 step of “transmitting data on a time at which an ordered media object is available by the center to the communications terminal.”

Thus, as there is clearly a teaching away from using downloading and play back in Zhao, there is no reasonable basis established as to modifying the download-play back teachings of Downs by the streaming teachings of Zhao and a reversal of the outstanding rejection for the above-noted reasons based on an improper hindsight rationale that ignores the teaching away of Zhao is clearly in order.

4. The rejection rationale fails to establish any reasonable basis to combine the teachings of the two disparate references relied upon.

It is well established that the PTO has the burden to “explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.” See *In re Rouffet*, 149 F. 3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). It is also well established that this burden is met “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” See *In re Fritch*, 972 F.2d 1250, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). No such reasonable explanation has been presented.

Instead, the final Action asserts that an abstraction of the actual teachings of Zhao can be relied upon at page 4, lines 5-9, thereof. This rationale fails to consider that Zhao is concerned with maximizing bandwidth efficiency “in distributed continuous media streaming systems” (see lines 1-2 and of the Zhao Abstract) that are not applicable to the Downs use of SC(s) that are “downloaded” by the end users (see column 11, lines 40-42, for example). Simply put, the PTO cannot reasonably take the Zhao optimal data multiplexing technique out of context, i.e., without the statement in lines 7-10 of the Abstract that tie it to “exploiting both the temporal and the spatial structures among a group of continuous media streams.” When properly taken in context, it is clear that the teachings of Zhao are completely contrary to the Downs use of SC(s) that are “downloaded” by the end users, as noted above.

Thus, as there is clearly no reasonable basis that has been established as to modifying the download-play back teachings of Downs by the contrary “streaming” teachings of Zhao, a reversal of the outstanding rejection based on this improper hindsight rationale that ignores the full teachings of Zhao is clearly in order.

B. Dependent Claims 2-12 and 14-22

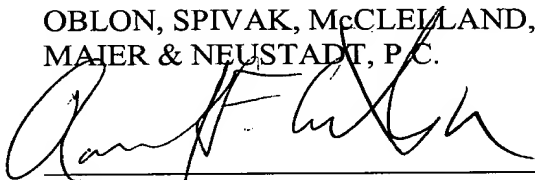
The rejection of dependent Claims 2-12 and 14-22 should be reversed for the reasons noted above as to independent Claims 1 and 13.

CONCLUSION

The rejections applied to Claims 1-22 should all be reversed as being clearly improper under the controlling precedent cited above and for the above-noted reasons.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'Gregory J. Maier', is written over a horizontal line.

Gregory J. Maier
Attorney of Record
Registration No. 25,599
Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 06/04)

VIII. CLAIMS APPENDIX

1. A method for ordering and transmitting digital media objects, comprising:

transmitting an object order for digital media objects that comprises at least one object identification by a mobile communications terminal over a mobile radio network to a center, transmitting data on a time at which an ordered media object is available by the center to the communications terminal, wherein the time is determined by the center with regards to optimal usage of resources used for a transmission of ordered media objects and is stored in the communications terminal,

automatically contacting, by the communications terminal, the center at the time,

transmitting a media object assigned to the object identification by the center via a radio network to the communications terminal, where the media object is stored in a memory, and

playing back, by a media playback module of the communications terminal, a media content included in the stored media object.

2. The method according to claim 1, wherein prior to transmission to the communications terminal, the media content of the media object is encrypted with a first key, assigned to said media object, and the media content is decrypted by said first key prior to playback through the media playback module.

3. The method according to claim 2, wherein media objects stored in a first said communications terminal are selected by the user of said first communications terminal and are transmitted to a second communications terminal, the media content of these media objects remaining encrypted.

4. The method according to claim 2, wherein the first key, assigned to the media object, is transmitted, encrypted by a public second key, to the respective communications terminal and is decrypted in the respective communications terminal by a private third key, the pair of keys, of the public second key and the private third key, being assigned to the user of the respective communications terminal.

5. The method according to claim 4, wherein data about conditions of use for the media object are also sent to the communications terminal separately or together with the first key assigned to said media object.

6. The method according to claim 4, wherein, for the decryption of the media content of the media object, the decrypted first key assigned to said media object is transmitted in a protected way to a decryption module of the communications terminal.

7. The method according to claim 1, wherein the media objects include in each case indications about the center where the respective media object can be obtained.

8. The method according to claim 2, wherein the media objects include in each case indications about a key server from which the encrypted first key can be obtained.

9. The method according to claim 8, wherein a key obtaining module of the respective communications terminal automatically requests, receives and stores the encrypted first key in each case from the key server.

10. The method according to claim 1, wherein the media objects include in each case indications concerning the media content of the media object, including at least one of price information, title indications, playing duration or a sample playback.

11. The method according to claim 1, wherein as payment for the playback of the media content of the media object a monetary amount assigned to said media object is debited against a prepaid monetary amount stored on a chipcard of the respective communications terminal.

12. The method according to claim 1, wherein the number of playbacks of said media content of the media object is counted in the respective communications terminal, and the number of playbacks is transmitted to a license server.

13. A mobile communications terminal configured to receive data disseminated over a radio network and configured to communicate over a mobile radio network, wherein said mobile communications terminal comprises:

at least one processor;

memory means connected to said at least one processor, wherein at least one of the memory means is configured to store digital media objects received over the radio network;

a programmed order module configured to transmit an object order for digital media objects over the mobile radio network to a center, including at least one object identification;
and

a media playback module configured to play back a media content included in one of said digital media objects via a suitable medium,

wherein the order module is configured to receive and store a time, determined by the center with regards to optimal usage of resources used for a transmission of ordered media objects and transmitted to the communications terminal, at which an ordered media object is available, and

wherein the order module is further configured to contact the center at the time and store in the memory means a media object assigned to the object identification, which object is transmitted by the center via a radio network to the communications terminal.

14. The communications terminal according to claim 13, wherein the communications terminal further comprises a decryption module which is configured to decrypt the encrypted media content of the media object by a first key assigned to said media object.

15. The communications terminal according to claim 14, wherein the communications terminal further comprises a transmission function which is configured to transmit stored media objects to a second mobile communications terminal, the media content of said media objects remaining encrypted.

16. The communications terminal according to claim 14, wherein the communications terminal further comprises a key obtaining module, wherein said key obtaining module is configured to obtain a first key, assigned to the media object, from a key server via the mobile radio network, and the communications terminal comprises a second decryption function which is configured to decrypt, by a private third key, the received first key that is encrypted with a public second key, the pair of keys, of said public second key and the private third key, being assigned to the user of the communications terminal.

17. The communications terminal according to claim 16, wherein, the key obtaining module is configured such that, separately or together with the first key assigned to a said media object, the key obtaining module also obtains data about conditions of use for said media object.

18. The communications terminal according to claim 16, wherein said second decryption function is configured to pass on the decrypted first key in a protected way to the decryption module.

19. The communications terminal according to claim 16, wherein the key obtaining module is configured to automatically obtain from the key server the encrypted first key on the basis of indications about the key server, which indications are included in each case in the media object.

20. The communications terminal according to claim 13, wherein the communications terminal further comprises a billing module, wherein said billing module is configured such that, with the playback of the media content of the media object, the billing module debits a monetary amount assigned to said media object against a prepaid monetary amount stored on a chipcard of the communications terminal.

21. The communications terminal according to claim 13, wherein the communications terminal further comprises a license module, wherein said license module is configured to count the number of playbacks of the media content of the media object in the communications terminal, and transmits said number to a license server.

22. The communications terminal according to claim 13, wherein the memory means comprises at least one memory area on a chipcard, and said private third key is stored in the at least one memory area.

IX. EVIDENCE APPENDIX

None

X. RELATED PROCEEDINGS APPENDIX

None